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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,819	04/19/2005	Masayuki Kawakami	LEDER-0010	5431

23599 7590 03/07/2008

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EXAMINER	
JONES, DAMERON LEVEST	

ART UNIT	PAPER NUMBER
1618	

MAIL DATE	DELIVERY MODE
03/07/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/506,819	KAWAKAMI ET AL.	
	Examiner	Art Unit	
	D. L. Jones	1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *1/10/08*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4,5,8 and 11-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,4,5,8 and 11-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

ACKNOWLEDGMENTS

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/10/08 has been entered.

2. The Examiner acknowledges receipt of the amendment filed 1/10/08 wherein claims 1, 8, and 11-13 were amended; claims 3, 6, 7, 9, and 10 were canceled; and claims 14-18 were added.

Note: Claims 1, 2, 4, 5, 8, and 11-18 are pending.

RESPONSE TO APPLICANT'S AMENDMENT/ARGUMENTS

3. The Applicant's arguments and/or amendment filed 1/10/08 to the rejection of the claims made by the Examiner under 35 USC 112 and/or double patenting rejections have been fully considered and deemed persuasive-in-part for the reasons set forth below.

Double Patenting Rejections

The rejection of claims 1, 2, 4, 5, and newly added claims 17 and 18 on the ground of non-statutory obviousness-type double patenting as being unpatentable over

claims 1-8 of US Patent No. 6,939,975 is MAINTAINED for reasons of record in the office action mailed 10/18/07 and those set forth below.

Applicant asserts that the double patenting rejection should be withdrawn because independent claim 1 has been amended to incorporate that the pharmaceutically acceptable carrier for diagnostic imaging is 'injectable'.

Applicant's argument is not persuasive for the following reasons. First, Applicant is reminded that the claims are directed to a product; thus, a recitation of intended utility of the product does not impart patentability to a known composition. In other words, a recitation of the intended utility of a product claim which can otherwise stand alone is not considered a further limitation of the claim (*In re Spada*, 911 F.2d 535, 152 USPQ 602 (CCPA 1967) and *In re Ridden*, 318 F. 2d, 138 USPQ 112). In other words, a product claim is evaluated based on the component/components present in the product, not on what the product will be used for. Secondly, Applicant is reminded that merely claiming an old compound in combination with a carrier does not render the combination patentable if it would be obvious to utilize a carrier with the compound (*In re Rosicky* (CCPA 1970) 276 F2d 656, 125 USPQ 341). Furthermore, it is noted that the claims US Patent No. 6,939,975 are product claims and are not limited to a particular use such as for photographic purposes. In addition, the term 'carrier' as defined in any general dictionary (e.g., Webster's New Riverside University Dictionary, page 232) is 'a component that transports or conveys; a mechanism by which something is convey or conducted. Hence, the skilled practitioner in the art would recognize that the purpose of the carrier is transport the cyanine dye from one place to a desired location. Thus,

since the dyes are the same, the properties of the dyes of the instant invention and those of US Patent No. 6,939,975 would be the same. Hence, if the dye of the instant invention may be used as a contrast agent, so would the dye of the patented invention since the carrier does not materially alter the overall properties of the dye. Also, it should be noted that both the instant invention and the patented invention disclose that the compounds used are light sensitive and are used to yield images.

112 Second Paragraph Rejections

The 112, second paragraph, rejections are WITHDRAWN for reasons of record in Applicant's response.

NEW GROUNDS OF REJECTIONS

112 Second Paragraph Rejections

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, 4, 5, 8, and 11-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims as written are ambiguous because it is difficult to read some of the bonds, subscripts, and charges in the structures and variable definitions of independent claim 1 and claim 4. Hence, since all claims depend on independent claim 1, those claims are also vague and indefinite.

COMMENTS/NOTES

6. In claim 1, line 13, did Applicant intend to write "R^{11}," instead of "R^{11},". Please make the appropriate correction(s). The comma in the phrase should not be a superscript.

7. It is once again noted that no prior art has been cited against the instant claims. However, Applicant MUST address and overcome the double patenting and 112 second paragraph rejections above. The claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious the contrast agents of the instant invention or uses thereof. The closest art is Applicant's own work which is cited in the double patenting rejection above.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (571) 272-0617. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. L. Jones/

D. L. Jones
Primary Examiner
Art Unit 1618

February 27, 2008